

**REMARKS**

Claims 1-27 are currently pending in the application. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

***Allowed Claims***

Applicants appreciate the indication that claims 15 – 20 are allowed and that claims 1 – 14 and 21 – 27 contain allowable subject matter. However, Applicants submit that all of the claims are in condition for allowance for the following reasons.

***35 U.S.C. §101 Rejection***

Claims 1, 21 and 27 were rejected under 35 U.S.C. §101 for not being supported by either a specific and substantial asserted utility or a well established utility.

The guidance for the “utility requirement” inquiry is provided by the following passage of the MPEP:

For an invention to be "useful" it must satisfy the utility requirement of section 101. The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP Sec. 2107... (MPEP §2106 IV.C.2.(2).a).

Furthermore, the Examiner's attention is directed to MPEP §2107, which provides the following examination guidelines for the utility requirement

Office personnel are to adhere to the following procedures when reviewing patent applications for compliance with the “useful invention” (“utility”) requirement of 35 U.S.C. 101 and 112, first paragraph.

(B) Review the claims and the supporting written description to determine if the applicant has asserted for the

claimed invention any specific and substantial utility that is credible:

(1) If the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a “specific and substantial utility”) and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.

With regards to claims 1, 21 and 27, Applicants submit that the instant claimed invention complies with the above-noted provisions of MPEP §2107 because its utility is asserted in at least paragraphs [0019] and [0020] of the Specification. More particularly, it is asserted at paragraph [0019] of the Specification that:

This invention is directed to a system and method of manipulating chip design data and kerf design data concurrently so that the same manipulation processing is applied to both the chip design and the kerf design for substantially reducing errors and improving the accuracy of resulting data. Concurrent manipulation of the chip design data and kerf design data provides for several advantages including minimized data errors, reduced design workload by designers, improved cycle time, consistent accurate repeatable process, improved quality of wafer testing because kerf matches data in the chip, and improved reliability if using kerf to test the chip (especially for multi-part number products).

Additionally, it is asserted at paragraph [0020] of the Specification that:

... the invention also provides for reduced cycle time in mask manufacturing process because the kerf build is already performed prior to the mask manufacturing process, reduction in inputs by a customer (or user) which results in improved quality and cycle time.

Accordingly, as Applicants have asserted that the claimed invention is useful for a specific and substantial purpose, and that the assertion would be considered credible by a person of ordinary skill in the art, Applicants submit that the rejection based upon a lack of utility is improper.

Additionally, with regards to claim 1, Applicants submit that manipulating the kerf data does produce a tangible and concrete result—manipulated kerf data that is manipulated using the same manipulation process as was used for the chip data. Furthermore, as discussed above, this manipulated kerf data has a specific and substantial asserted utility.

Additionally, Applicants submit that claim 21 is directed to a system for generating kerf data. The system comprises, inter alia, components to submit chip data for chip processing, to generate kerf data corresponding to the chip data, and to manipulate the kerf data via kerf processing using the same manipulation process as the chip data. Therefore, claim 21 is directed to statutory subject matter because it falls within the enumerated statutory category of a machine and does not cover a recognized judicial exception. Moreover, claim 21 produces a useful, tangible, and concrete result for the same reasons discussed above with respect to claims 1, 21 and 27.

Furthermore, Applicants submit that claim 27 recites a computer program product comprising a computer usable medium having readable program code embodied in the medium, the computer program product includes a first computer program code to submit chip data for chip processing, a second computer code to generate kerf data corresponding to the chip data, and a third computer program code to manipulate the kerf data via kerf processing using the same manipulation process as the chip data.

In discussing computer-related subject matter, MPEP §2106 provides the following guidance:

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

...

[A] claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Based upon the above-noted passages, Applicants submit that claim 27 is directed to statutory subject matter because claim 27 recites a computer-readable medium encoded with a computer program (e.g., computer program product comprising a computer usable medium having readable program code embodied in the medium). Moreover, claim 27 produces a useful, tangible, and concrete result for the same reasons discussed above with respect to claims 1, 21 and 27.

Therefore, Applicants respectfully request that the rejection over claims 1, 21 and 27 be withdrawn.

### ***35 U.S.C. §112 Rejection***

Claims 1, 21 and 27 were rejected under 35 U.S.C. §112, 1<sup>st</sup> paragraph because one skilled in the art would not know how to use the invention, since the invention is not supported by either a specific and substantial asserted utility or a well established utility.

As discussed above, Applicants submit that the invention is supported by a specific and substantial asserted utility. Further, Applicants submit that one skilled in the art would know how to use the invention. Accordingly, Applicants respectfully request that the rejection over claims 1, 21 and 27 be withdrawn.

***Other Matters***

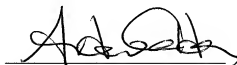
In response to the Statement of Reasons for Allowance provided in the Office Action, Applicants wish to clarify the record with respect to the basis for the patentability of claims in the present application. In this regard, while Applicants do not disagree with the Examiner's indication that certain identified features are not disclosed by the references, Applicants submit that each of the claims in the present application recite a particular combination of features, and that the basis for patentability of each of these claims is based on the totality of the particular features recited therein.

Additionally, Applicants note that the Examiner's statement that: "[c]laims 1 – 14 and 21 – 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 101 and 35 U.S.C §112, 2<sup>nd</sup> paragraph, set forth in this Office Action" is inaccurate. Applicants note that no claims were rejected under 35 U.S.C §112, 2<sup>nd</sup> paragraph. Applicants believe that the Examiner intended to cite 35 U.S.C §112, 1<sup>st</sup> paragraph.

**CONCLUSION**

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0456.

Respectfully submitted,  
Howard T. BARRET

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', is written over a horizontal line.

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